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09/939,369	08/24/2001	Lou Chauvin	83304AF-P	3908

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EXAMINER

ZHONG, CHAD

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/939,369

Applicant(s)

CHAUVIN ET AL.

Examiner

Chad Zhong

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-22 are presented for examination.
2. It is noted that although the present application does contain line numbers in specification and claims, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.
3. Applicant is required to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification. The status of all citations of US filed applications in the specification should also be updated where appropriate.
4. The use of the trademark Kodak among others have been noted in this application (pg 10, line 18). It should be capitalized wherever it appears and be accompanied by the generic terminology. Appropriate correction is required to the entire application.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 (c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-5, 8-13, 16-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Smart et al. (hereinafter Smart), US 2003/208691.
7. As per claim 1, Smart teaches a method of linking a digital photographic imaging service

requester to a service provider selected from a plurality of different service providers, comprising:

g) providing a services directory which includes entries for a plurality of services, each service associated with at least one of said plurality of different service providers (see for example, pg 3, [0053], a service directory comprising of plurality of services where each service can discover information about other services);

h) selecting of a service by the service requester to be provided with respect to a digital image ([0077-0078], [0175] where user select the services pertaining to a camera, to access pictures or to print out photos at a remote print shop service);

i) automatically providing the requester with a list of one or more of said plurality of different service providers based on a criterion (pg 8, [0116]; table 1, criteria(s) can be manual selected, the directory services comprising list of available services is one such example);

j) said requester selecting one of said plurality of different service providers from said list (pg 5, [0077-0078]; pg 8, [0116]; table 1; [0170], where the user selects services through command string or program to perform the set of desired services and actions, such as printing out the images using a print shop service);

k) providing a request for a desired service to the selected service provider (pg 10-11, [0127]; Fig 15, item 508, where the request for desired service is to print out the image, the request is forwarded to print shop service for print purposes); and

l) providing of said desired service by said selected service provider (pg 15, [0170], where the image is printed out at the print shop service).

9. As per claim 2, Smart teaches:

the criterion comprises a location of a designated recipient (pg 7, [0095-0101], physical location, supported commands etc. of the service can offer).

10. As per claim 3, Smart teaches:

the criterion is selected from one of the following:

Brand

Cost of service

Specific product characteristics ([0095-0096], supported resolution)

Delivery time

Delivery method

Delivery reach

Specific provider characteristics ([0095-0101], provider characteristics)

Access time

Ability to ship to specific location

11. As per claim 4, Smart teaches:

said automatically providing of said list is accomplished through the use of a locator service (pg 3, [0053]).

12. As per claim 5, Smart teaches:

said criterion is a dynamic criterion ([0053], [0095-0101] wherein the criterion changes based on for example client's needs on resolution of the print job, supported image formats).

13. As per claim 8, Smart teaches:

said dynamic criterion comprises the work flow capacity of the provider ([0095-0101], amount/types of resolution supported by the service, available images, and supported format have a direct effect on the work flow or the types of work or instances of work the provider can support. For example, a low image printer on the provider side can not support high quality image print outs, thus restricting the work flow

capacity of the provider).

14. As per claim 9, Smart teaches:

said dynamic criterion is automatically adjusted based on predetermined criterion (pg 8, [0116]; table 1, wherein these criteria are predetermined based on user's sample selection, for example, print quality or image formats, these parameter values can be changed dynamically based on predetermined user desired photo quality).

15. As per claim 10, Smart teaches:

said requester selecting one of said plurality of different service providers from said list further comprises obtaining a subset of providers from said list based a second criterion (pg 10-11, [0127], wherein in the printer is unable to process the user's request, thus a remote 3<sup>rd</sup> party printer's services is solicited, resulting in processing of the print job on said first printer's behalf. Fig 20, item 2012, 2014).

16. As per claim 11, Smart teaches:

said criterion is directly associated with the digital image (table 1, [0095-0101], wherein the association is in terms of photo quality).

17. As per claim 12, Smart teaches:

said second criterion comprises one of the following:

least expensive

closest (table 1, I/O matching; [0097]).

18. As per claim 13, Smart teaches:

the service provider is positioned on the display screen of imaging client according to a business criteria (pg 12, [0170], wherein the business criteria comprises at least one of plurality of printer services located across the network, and said services are displayed and further selected by the end user).

19. As per claim 16, Smart teaches:

said business criteria is based the image capture device (Fig 1, 2, wherein the image capturing device is digital camera, clients can view digital images from the camera; [0170], the camera provides the print shop service with desired service specifications and characteristics during the profile matching process).

20. As per claim 17, Smart teaches:

wherein said image capture device comprises a digital camera (Fig 2, item 102).

21. As per claim 18, Smart teaches:

image capture device is programmed at the time of purchase (wherein the digital cameras are inherently pre-configured to have software running within the camera, comprising software menus and interfacing drivers).

22. As per claim 19, Smart teaches:

a kiosk is used to access the service provider (pg 2, [0042], [0045-0047], wherein each devices on Fig 1 can be considered as a general computer system 2100).

23. As per claim 20, Smart teaches a system for providing imaging services over a communications network, including:

f) a first device having a user interface for receiving commands from a user and a network interface (Fig 1 and 2, [0042], wherein the user contacts the directory service through the terminal, functions are interpreted and or implemented using software, such as an application program, executing within the device and configured where appropriate to communicate with other devices in the system),

g) a plurality of different service providers connected to said communication network (Fig 2, item 104, 106 wherein the service providers have printer services for digital photographs),

h) a computer having a network interface for communication to said first device over said communication network, wherein said computer having a services directory having entries for a plurality of services, at least one service is associated with said plurality of different service providers, each of said plurality of different service providers having associated information (see for example, pg 3, [0053], a service directory comprising of plurality of services where each service can discover information about other services, high resolution printer service offers different associated information compared to low resolution printers);

i) wherein the user, using said first device, selects a service ([0077-0078], [0175] where user select the services pertaining to a camera, to access pictures or to print out photos at a remote print shop service);

j) said computer automatically provides a list of at least one of said plurality of different service providers based on a criterion using said associated information (pg 8, [0116]; table 1, criteria(s) can be manual selected, the directory services comprising list of available services is one such example);

k) said selected service provider providing said requested service (pg 15, [0170], where the image is printed out at the print shop service).

24. As per claim 21, claim 21 is rejected for the same reasons as rejection to claims 1 and 20 above.

25. As per claim 22, claim 22 is rejected for the same reasons as rejection to claims 1 and 20 above.

***Claim Rejections - 35 USC § 103***

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having



ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 6-7, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smart et al. (hereinafter Smart), US 2003/208691, in view of what was well known in the art.

28. As per claim 6, Smart does not explicitly teach price. Official Notice is taken (see MPEP 2144.03) price value is well known and routinely used for agreeing for types of services offered, acting as a binding agreement between purchaser and the provider. It would have been obvious to one of ordinary skill in the art to include dynamic criterion comprising price with Smart because it would provide for an electronic commerce environment, by allowing for price agreement for a particular service.

29. As per claim 7, Smart teaches the method according to claim 6 wherein said dynamic criterion is set for a predetermined period of time (see for example, table 1, wherein the print job has an expected time of completion).

30. As per claim 14, Smart does not explicitly teach amount paid by the service provider to be on said service directory. Official Notice is taken (see MPEP 2144.03) amount paid by the service provider to be on service directory is well known and routinely used as a criteria prior to offering such a directory service. It would have been obvious to one of ordinary skill in the art to include fee based directory services with Smart because it would provide for an electronic commerce environment, by allowing for a fee based directory service to provide for additional revenue.

31. As per claim 15, Smart does not explicitly teach a contract. Official Notice is taken (see MPEP 2144.03) a contract is well known and routinely used between service provider and service recipient acting as a binding agreement between the two parties. It would have been obvious to one of ordinary skill in the art to include a contract with Smart because it would provide for a binding agreement between

two parties within a electronic commerce system, by allowing for a form of agreement to perform fair business practices.

*Conclusion*

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and publications are cited to further show the state of the art with respect to "SYSTEM, METHOD AND SOFTWARE PRODUCT FOR ALLOWING A CONSUMER TO ORDER IMAGE PRODUCTS OVER A COMMUNICATION NETWORK FROM A PLURALITY OF DIFFERENT PROVIDERS".

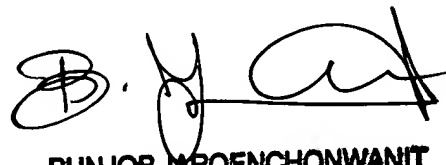
- i. US 2003/0011801 Simpson et al.
- ii. US 6195667 Duga et al.
- iii. US 5764866 Maniwa, Yoshio

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Zhong whose telephone number is (571)272-3946. The examiner can normally be reached on M-F 7:15 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAROENCHONWANIT, BUNJOB can be reached on (571)272-3913. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CZ  
December 5, 2005



**BUNJOB JAROENCHONWANIT**  
**PRIMARY EXAMINER**